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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,476	06/24/2003	Edwin G. Duffin	P-9797.00	7245
27581 7590 02/14/2007 MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			EXAMINER KAHELIN, MICHAEL WILLIAM	
			ART UNIT	PAPER NUMBER
			3762	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/601,476

Applicant(s)

DUFFIN ET AL.

Examiner

Michael Kahelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 21-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Inventions I (claims 1-9) and II (claims 21-25) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that a second connector contact be connected to the first bore contact. The subcombination has separate utility such as use in a system not requiring elongated insulated conductors in the lead, but exterior to the lead body.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such

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claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-3, 5, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sluetz et al. (US Re. 31,990), in view of Doan et al. (US 7,031,774, hereinafter "Doan") and Goldreyer (US 4,365,639, hereinafter "Goldreyer"). Sluetz discloses the essential features of the claimed invention including the following:

7. In regards to claims 1 and 3, Sluetz discloses a system comprising an array of electrodes (68 and 69), an assembly of insulated conductors (65), a lead connector with a linear array of contacts to select an electrode (Fig. 1), a pulse generator with a connector bore (18) wherein at each position of the lead connector, a lead connector contact makes connection with the connector bore contact (16) to make a corresponding one of the electrodes as a connected active electrode because it is in communication with the device electronics, and a means for reversibly locking the connector along multiple positions in the bore (col. 6, line 21, and 25).

8. Sluetz does not disclose that, at each position of the lead connector, a first contact and third contact are electrically connected to the pulse generator and a second contact is electrically disconnected from the pulse generator. Doan teaches of providing a sliding electrode selection means wherein at each position of the lead connector, a first contact and third contact are electrically connected to the pulse generator and a second contact is electrically disconnected from the pulse generator (Figs. 4 and 5) to allow various combinations of electrodes to be in electrical communication with the pulse generator, thusly allowing the location of stimulation to be adjusted after final lead implantation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sluetz' invention by providing a sliding

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electrode selection means wherein at each position of the lead connector, a first contact and third contact are electrically connected to the pulse generator and a second contact is electrically disconnected from the pulse generator to allow both the polarity and location of stimulation to be adjusted after final lead implantation.

9. Further, Sluetz does not disclose that the electrodes are distributed circumferentially on the lead body. Goldreyer teaches of providing a system having pacing lead with multiple selectable, circumferentially spaced electrodes (21-24) to sense in a very specific area to determine local effects. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz's invention with a pacing lead with multiple selectable, circumferentially spaced electrodes to sense in a very specific area to determine local effects.

10. In regards to claim 2, the connector comprises a second contact to make a second electrode as a connected active electrode because it is connected to the internal electronics (17).

11. In regards to claim 5, the means for locking the connector includes a deflectable member projecting into the bore (25).

12. In regards to claim 9, the means for locking includes an actuated member (27 and col. 6, line 3).

13. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sluetz in view of Doan and Goldreyer, as applied to claim 1 above, and further in view of Bischoff et al. (US 5,843,141, hereinafter "Bischoff"). Sluetz's modified invention

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discloses the essential features of the claimed invention except for an insertion tool and a set of spacers with surface depressions in which deflectable members rest. Bischoff teaches of providing a multiple connector lead system with an insertion tool to easily pull the lead into cooperation with the energy applicator and a set of spacers with surface depressions in which deflectable members rest to electrically isolate the electrodes and provide a fixation means for the lead. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz's modified invention with an insertion tool to easily pull the lead into engagement with the energy applicator and a set of spacers with surface depressions in which deflectable members rest to electrically isolate the electrodes and provide a fixation means for the lead. Please note that the surface depressions can be seen in Figure 6.

14. Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sluetz in view of Doan and Goldreyer, as applied to claim 1 above, and further in view of Peers-Trevarton (US 4,469,104, hereinafter "Peers-Trevarton"). Sluetz's modified invention discloses the essential features of the claimed invention except for deflectable members that rest in surface depressions on the contacts and deflectable members that rest in depressions apart from the array of contacts. Peers-Trevarton teaches of providing a multiple electrode connection device with deflectable members that rest in surface depressions on contacts (140) to ensure a close electrical communication between the two contacts and deflectable members that rest in depressions apart from the array of contacts (101) to create a barrier between fluids and the contacts and

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provide a tight fit for the lead in the bore. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Sluetz's modified invention with deflectable members that rest in surface depressions on contacts to ensure a close electrical communication between the two contacts and deflectable members that rest in depressions apart from the array of contacts to create a barrier between fluids and the contacts and provide a tight fit for the lead in the bore. Please note that the examiner is interpreting the surface depression in which the deflectable member rests is the unlabelled feature in proximity to element 172 in Figure 1.

Response to Arguments

15. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MWK
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George Evans
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2/12/07